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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,123

07/15/2003

Alois Schoenweger

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07/31/2006

DUANE MORRIS, LLP

IP DEPARTMENT

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PHILADELPHIA, PA 19103-4196

EXAMINER

GROSSO, HARRY A

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,123

Applicant(s)

SCHOENWEGER, ALOIS

Examiner

Harry A. Grosso

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-10, 12 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 12 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/12/06</u> . | 6) <input type="checkbox"/> Other: _____ |

The objection to the drawings has been overcome by the amendment filed May 12, 2006. The objection is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1,2, 4, 10,12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Huff (2,143,517).
2. Regarding claim 1, Huff discloses a flush-mounting box with an open front, an edge, sidewalls, a base (Figures 1, 3 and 4, page 1, column 1, lines 1-5) and a flange (6). The device has plural means on the box for fastening the flange and the flange can be fastened a variable distance from the front edge by inverting the flange (Figures 3 and 4). Plumbing elements can be installed within the box through openings (2, page 1, column 1 lines 45-47).
3. Regarding claim 2, Huff discloses the flange can be a solid ring (page 2, column 1, lines 3-5)
4. Regarding claims 4, 10 and 12, Huff discloses the flange is fastened directly to the outer surfaces of the sidewall of the box with a bayonet joint (Figures 2-4, page 1, column 1, line 55 to column 2, line 10). The flange is fastened to the box from the open front of the box.

5. Regarding claim 15, Huff discloses the flange may be latched into position. (7, 8, page 1, column 2, lines 20-23 and 46-50).
6. Claims 1-4, 10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bossert (754,414)
7. Regarding claim 1, Bossert discloses a flush-mounted box with an open front (Figures 4 and 5), an edge (y), and a flange (a) on an outside of the box. The box has plural means (m) for fastening the flange to the box at variable distance back from the edge (page 1, lines 79-94). Plumbing elements can be installed within the box through openings in the device created by removing typical knock-outs.
8. Regarding claim 2, the flange is a solid ring (Figure 1).
9. Regarding claim 3, the device has a plurality of structures spaced back from the edge at the open front on the outer surface of the sidewall for fastening the flange.
10. Regarding claim 4, the flange is fastened directly to the box.
11. Regarding claim 10, the joint between the box and the flange is a bayonet joint.
12. Regarding claim 16, Bossert discloses a flush mounting box that has an open front at edge (y), a plurality of grooves on the outside of the sidewalls of the box (m) at different distances from the edge and a flange (a) with inward protrusions (e) that engage the grooves. Plumbing elements can be installed within the box through openings in the device created by removing typical knock-outs.
13. Claims 1, 3, 4, 7, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ullman (4,053,082).

14. Regarding claim 1, Ullman discloses a flush-mounting box (12, Figures 1 and 2) having an open front edge, sidewalls (40), a flange (20) and plural means (44) on the box for fastening the flange at a variable distance from the edge. Plumbing elements can be installed within the box through openings in the device created by removing typical knock-outs (47).
15. Regarding claim 3, the device has a plurality of structures spaced back from the edge at the open front on the outer surface of the sidewall for fastening the flange (column 5, lines 55-69).
16. Regarding claim 4, the flange is fastened directly to the box.
17. Regarding claim 7, the flange and the sidewall are engaged at ribs (44) having 0 degrees pitch angle on the flat side.
18. Regarding claims 8 and 9 the ribs are interrupted down to the root of the ribs.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ullman in view of Rosler (4,046,279).
21. Regarding claim 16, Ullman discloses a flush-mounting box (12, Figures 1 and 2) having an open front edge, sidewalls (40), a flange with inward protrusions (20) and plural means (44) on the box for fastening the flange at a variable distance from the

edge. Plumbing elements can be installed within the box through openings in the device created by removing typical knock-outs (47).

Ullman does not teach grooves on an outside of the box with the inward protrusions engaging the grooves. Rosler discloses a box (1) with an open front end and an edge, grooves (4) on the outside of the box for securing a flange (2) at varying distances from the edge (Figures 1 and 7) and inward protrusions (9) on the flange for engaging the grooves. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of the grooves on the outside wall of the box and corresponding inward projections on the flange as disclosed by Rosler in the box disclosed by Ullman to provide an outer surface on the box without protrusions that could interfere with installation of the box and provide a means for positive locking of the flange on the box.

22. Regarding claim 17, Rosler discloses tangential surfaces (14) protruding radially on the outside of the box to provide stop-like members preventing rotation of the flange from the grooves (column 5, lines 51-63) and a gap (3) along which the inward protrusions of the flange are moveable back from the edge to engage selected grooves. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of the tangential surfaces and gaps as disclosed by Rosler to provide stop-like members preventing rotation of the flange from the grooves and a gap along which the inward protrusions of the flange are moveable back from the edge to engage selected grooves.

23. Regarding claim 18, Rosler discloses the grooves have broadened sections that receive the protrusions (16, column 6, line 9-15) to provide additional locking action against rotational movement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of broadened ends in the grooves as disclosed by Rosler to provide additional locking action against rotational movement.

Response to Arguments

24. Applicant's arguments filed May 12, 2006 have been fully considered but they are not persuasive. Applicant argues that Huff does not teach that one might mount plumbing fixtures in the box. In response, Huff provides a box with openings through which it would be capable of having plumbing elements of some type installed, thus it is capable of meeting the requirements of the claims.

25. Applicants argues that Huff does not meet the requirements of amended claim 1 in that Huff has bayonet slots of a fixed depth and the flange is mounted at a fixed location. In response, Huff has a plural means on the box for fastening the flange in that there is more than one bayonet slot and the flange can be fastened in two orientations as shown in Figures 3 and 4 of Huff thus providing means for fastening the flange at selectably variable distances (two) from the edge.

26. Applicant's arguments with respect to Kifer have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3727

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nathan Newhouse
Supervisory Patent Examiner
Art Unit 3727

hag